

WIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No. : 09/893,693 Examiner : El Chanti, Hussein A.
Filed : June 29, 2001 Conf. No. : 4959
Title : ENABLING COMMUNICATIONS OF ELECTRONIC DATA BETWEEN AN
INFORMATION REQUESTOR AND A GEOGRAPHICALLY PROXIMATE
SERVICE PROVIDER

Mail Stop Appeal Brief - Patents

Commissioner for Patents
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REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Applicant responds to the Examiner's Answer as follows

1) The ISP Server of Tarnanen is not a "primary communications system configured to act as an access point to the Internet for data communications between the client system and the Internet."

The Answer interprets the ISP server 13 to be "the primary communication system" which configured to act as an access point. Examiner's Answer, page 8. Applicant respectfully disagrees with this interpretation because Tarnanen does not teach or suggest a device that can act as the "primary communications system."

In particular, claim 30 recites a primary communications system that has two distinct functionalities:

- (1) it is configured to act as an access point to the Internet for data communications between the client system and the Internet, and
- (2) it is capable of identifying a secondary communications system that is more optimally suited for providing Internet access to the client's system than the primary communications system.

In Tarnanen, the specifically designated Internet Access Points (IAPs) perform the first functionality (i.e., provide Internet access to mobile stations). See, e.g., Tarnanen at 1:65-2:5; 3:32-50; 4:14-16; 6:26-31. The ISP server 13 or the Service Center (SC) 10 perform the second functionality (i.e., identify a more optimal access point). See, e.g., Tarnanen at 3:63-66; 4:1-4; 9:66-10:11. Nowhere does Tarnanen describe or suggest a single system entity that is capable of performing both of the above tasks. As will be explained in more detail, the IAPs of Tarnanen are distinct from the ISP server 13 or the SC 10. Neither the ISP server 13 nor the SC 10, alone

or in a combination, provide access to the Internet. Likewise, IAPs do not themselves identify more optimal access points.

The specification of Tarnanen makes it clear ISP server 13 and Internet SC 10 do not provide access to the Internet. This function is performed strictly by an Internet Access Point (IAP). Tarnanen explains that "the IAP is a server to which the user has access from a telephone in the fixed network or from a mobile telephone by making a modem call (or a data call) to a certain IAP access number." See id. at Col. 2:2-5. The service provider's network is divided into multiple IAP areas and "the mobile station roaming within the system tries to select the preferred IAP of each IAP area to access the Internet." See id. at Col. 3:32-50. (emphasis added).

In contrast to being an access point, the ISP server 13 merely stores IAP settings, as it an equipment or an application "maintaining IAP settings of IAP areas." See id. at Col. 4:28-32. The mobile station retrieves these settings "from a server, data base or the like maintained by the ISP." See id. at 3:65-66. Thus, the ISP server is not used by the mobile station as an access point to the Internet. Rather, the ISP server 13 only contains a list of IAP settings, "which links IAP areas with preferred IAP settings." See id. at Col. 9:65-68. The difference between IAPs and ISP server 13 is further underscored by the fact that there exist multiple IAPs for accessing internet from different locations, while there is only one dedicated ISP server for storing IAP settings. See e.g., id. at Fig. 1.

The Internet Service Center 10 is also not a "primary communications system configured to act as an access point to the Internet" that is also capable of "identifying a secondary communications system that is more optimally suited for providing Internet access to the client's system than the primary communications system," as recited in claim 30. Rather than being an access point, the SC 10 is a translating gateway between the GSM telephone network and the Internet data network. See id. at Fig. 1 and Col. 9:13-16. As a translating gateway, the SC 10 must always be present for the communications between the MS and the Internet. Thus, it is not possible to identify another SC that is "a secondary communications system that is more optimally suited for providing Internet access to the client's system than the primary communications system," as required by claim 30. For this reason, the SC cannot be a primary or a secondary communications system.

In summary, the Answer's interpretation of the ISP server 13 as a "primary communications system" is incorrect. Neither the ISP server 13 nor the SC 10, alone or in a combination, can be the "primary communications system configured to act as an access point to the Internet." Tarnanen designates special devices for this purpose and these devices are the Internet Access Points 14 and 15, which are distinct from both the ISP server 13 and the SC 10. However, as explained in the Appeal Brief, Tarnanen does not describe IAPs as capable of "identifying a secondary communications system that is more optimally suited for providing Internet access to the client's system than the primary communications system." See Appeal Brief at 13-14. Tarnanen instead describes the ISP server 13 or the SC 10 as performing this function. As a result, neither of IAPs, ISP server 13, and the SC 10 satisfies all requirements of the "primary communications system" limitation.

2) Applicant is entitled to a new Office Action because a feature added by amendment was not addressed by the Final Office Action nor by the Advisory Action, and was addressed instead for the first time in the Examiner's Answer.

The Answer does not explain why the Final Office Action failed to address an amendment made specifically to overcome Tarnanen ("a primary communications system configured to act as an access point to the Internet for data communications between the client system and the Internet.")). This limitation was never substantively addressed prior to the Examiner's Answer. See Appeal Brief at 10-11.

The Final Office Action did not address this limitation at all. See id. at 10-11. The subsequent Advisory Action also failed to properly discuss this limitation. See id. at 11-12. Specifically, the Advisory Action discussed the no-longer-pending claim language ("the first communications system)," but failed to address the actual language of claim 30. Id. at 12. The Advisory Action did not explain how Tarnanen teaches or suggests "a primary communications system configured to act as an access point to the Internet for data communications between the client system and the Internet." Instead of addressing the above limitation, the Advisory Action discussed how a mobile station of Tarnanen could be "a first communications system." Id.

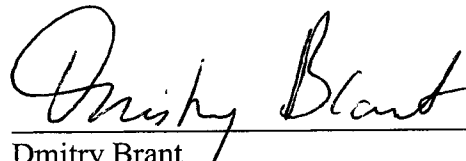
Now, it appears that the Examiner is taking yet another position. In particular, the Answer now asserts that the "primary communications system" is the ISP server 13 in Tarnanen. Once again, this is the first time that Applicant has seen this argument, which is manifestly improper, irrespective of the flaws to the argument explained in section 1. Moreover, a change in interpretation of Tarnanen as it is applied to a crucial term ("primary communications system") has now appeared in every new communication from the USPTO after the prosecution has been closed by the Final Office Action. Such continuous shifting of positions is clearly improper during the appeal process and warrants reopening of the prosecution. Applicant still has not received an Office Action taking all of the limitations into consideration. It is a well-established principle of patent examination that every limitation in the claim must be considered. MPEP § 2106.II.C. Moreover, when setting forth a rejection, the Office Action must clearly communicate its findings, conclusions and their bases to Applicant. MPEP § 2106.VII. Therefore, a new Office Action that properly addresses the limitations added in Applicant's Reply from May 8, 2007 is both appropriate and solicited.

For these reasons, and the reasons stated in the Appeal Brief, Applicant submits that the Final Rejection should be reversed or, at minimum, a new non-Final Office Action should be issued.

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Respectfully submitted,

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